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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,782	12/22/2000	Christer Fahraeus	63917	1423
2292	7590	02/24/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			NGUYEN, KIMNHUNG T	
			ART UNIT	PAPER NUMBER
			2677	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/746,782

Applicant(s)

FAHRAEUS, CHRISTER

Examiner

Kimnhung Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Amendment filed on 11/23/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-9,12-18 and 20-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,12-18 and 20-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/23/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

This application has been examined. The claims 1, 3-9, 12-18, 20-41 are pending. The examination results are as following.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-9, 12-13, 16-18 and 20-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni et al. (US 5,652,412) in view of Marianetti,II et al. (US 5,889,888).

Regarding claims 1, 18, 25-26, Lazzouni et al. discloses a handheld electronic device (see portable and field use of the input device, see col. 1, lines 19-20, and col. 2, lines 60-61) which is adapted to carry out at least one operation, comprising: a registration device (see pen 10, fig. 3); and processor means (see microprocessor for processing and recording the position information, see col. 4, lines 30-35) for carrying out an operation upon determination of a command (instrument for writing, see abstract), wherein the registration device (10) is adapted to record the command electronically by detecting a position code (see encoded position information, see col. 2, lines 44-52) arranged on a writing surface, upon which the command is written (see abstract, see col. 5, lines 7-12).

However, Lazzouni et al. does not disclose the registering strokes when the device is moved; interpretation means for determining if the strokes comprises a command.

Marianetti, II et al. discloses in figs. 1-3 a registration device (palmtop) for registering strokes (see recognize stroke, see abstract) when the device is moved; and an interpretation means (see interpreted as alphabetic, see abstract) for determining if the strokes comprises a command (see abstract, see col. 4, lines 10-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the using of registering strokes when the device is moved; interpretation means for determining if the strokes comprises a command as taught by Marianetti, II et al. into the system of Lazzouni et al. because this would recognize strokes that present characters from a different character set (see abstract), which provides an advanced user enters a command stroke followed by the command letter of the desired menu option (see col. 4, lines 8-10).

Regarding claim 3, Lazzouni et al. further discloses the registration device (10) an optical sensor (see detector for optical reading, see col. 4, lines 20-22) which is adapted to record images of the writing surface (see col. 5, lines 7-9), and a signal processor, which is adapted to use the position code in the images for providing a digital representation of the command (see col. 4, lines 30-42).

Regarding claims 4, 27, Lazzouni et al. discloses the signal processor comprises a character interpretation (alphabetic) function which is adapted to translate the digital representation of the command into character-coded format (see col. 2, lines 44-52)

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Regarding claims 5, 38, Lazzouni et al. discloses the registration device is adapted to record a message information quantity (see recording unit coupled to the pen, see abstract), which is used in the operation, in essentially the same way as the command is recorded (see abstract).

Regarding claim 6, Lazzouni et al. discloses further the registration device is adapted to record the information quantity by detecting a position code (see encoded position information) on a writing surface (see col. 2, lines 44-52).

Regarding claim 12, Lazzouni et al. discloses that the device is a mobile telephone (see col. 4, lines 43-46).

Regarding claim 7-9, 22-24 and 40 Lazzouni et al. discloses the device has at least two modes, one being a command mode for recording the command (see stroke) and the other being an information mode for recording the message information quantity (see recording the position of the pen tip, see abstract, see fig. 1).

Regarding claim 13, Lazzouni et al. discloses further the device is a digital pen for electronic recording of information (see fig. 3).

Regarding claim 16, Lazzouni et al. discloses a software program, which is stored on a memory medium (see figs 7-8, see memory 34), which can be read by a computer and which

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comprises instructions for causing the computer to detect a command (alphabetic), by electronically detecting a position code as discussed, written by means of a handheld electronic device, which is used as a pen, and to initiate a predetermined operation in response to the command (see fig. 7).

Regarding claim 17, Lazzouni et al. discloses a method for initiating an operation in a handheld electronic device, comprising: using the device as a pen (see figure 2); and writing a command symbol (see pen tip on the writing surface) to perform an operation on a surface that includes a position code (see encoded position information) on a writing surface (see col. 2, lines 44-52).

Regarding claims 20,37, Lazzouni et al. discloses the position code in the images (see encoded position information, see col. 2, lines 44-52), for providing a digital representation of the command.

However, Lazzouni et al. does not disclose the registering strokes is performed using an optical sensor which records images of the writing surface, and wherein determining if the strokes comprise a command.

Marianetti, II et al. discloses the registering strokes is performed using an optical sensor which records images of the writing surface, and wherein determining if the strokes comprise a command as discussed above.

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Regarding claims 21, 27, 32, Lazzouni et al. disclose a translating the digital representation of the command into character-coded format (see col. 2, lines 44-52).

Regarding claims 28, 33, Lazzouni et al. discloses the position code (as discussed above) codes each position by a plurality of marks and adjoining positions being partly coded by means of the same marks (see fig. 1), and wherein the device further comprises decoding means (see C4 decoding algorithm, see col. 11, lines 5-6) for decoding the position code.

Regarding claims 29, 33-34, Lazzouni et al. does not disclose the interpretation means are arranged to interpret the strokes as a command when the strokes are written on part of the position code which codes predetermined positions. Marianetti, II et al. discloses the interpretation means are arranged to interpret the strokes as a command when the strokes are written on part of the position code which codes predetermined positions (see abstract, and discussed above).

Regarding claims 30, 35, Lazzouni et al. does not disclose the command is a command to carry out an operation from the group of operations including dialing a telephone number.

Marianetti, II et al. discloses the command is a command to carry out an operation from the group of operations including dialing a telephone number (see col. 3, lines 38-42).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the a command to carry out an operation from the group of operations including dialing a telephone number as taught by Marianetti, II et al. into the system of

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Lazzouni et al. because this would provide to the user to have a simple method of writing numbers (see col. 3, lines 43-45).

Regarding claims 31, 36, Lazzouni et al. does not disclose the command is written by alphanumerical characters.

Marianetti et al. discloses the command is written by alphanumerical characters (see col. 4, lines 2-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the command is written by alphanumerical characters as taught by Marianetti et al. into the system of Lazzouni et al. because this would provide an advanced user enters a command stroke followed by the command letter of the desired menu option (see col. 4, lines 7-10).

Regarding claim 32, Lazzouni et al. does not disclose the interpretation means comprises character recognition means for translating the command to character-code format.

Marianett et al. discloses the interpretation means comprises character recognition means (see recognition device having Katakana, Roman characters 530, 540 fig. 5) for translating the command to character-code format (see col. 4, lines 59-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the interpretation means comprises character recognition means for translating the command to character-code format as taught by Marianett et al. into the system of



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Lazzouni et al. because this would provide to the user the desired character symbols and translated into their code (see col. 5, lines 25-27).

Regarding claim 38, Lazzouni et al. discloses the registration device is adapted to record a message information quantity (see abstract), which is used in the operation.

However, Lazzouni et al. does not disclose that the registration is used the same way as the command is recorded. Marianett et al. discloses the command strokes by the letters (see col. 4, lines 2-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the using of the command strokes by letters as taught by Marianett et al. into the system of Lazzouni et al. with recording unit coupled to the pen of Lazzouni et al. because this would invoke a menu option with associated command letter, and help the user enters a command stroke followed by the command letter of the desired menu option.

Regarding claim 39, Lazzouni et al. discloses the registration device is adapted to record the information quantity by detecting the position code on a writing surface as discusses above.

Regarding claim 41, Lazzouni et al. discloses further wherein the position code encodes position by directions of displacements of dots from raster point (see figs. 6A-6C, see vertical and horizontal data lines (102, 108, 104, 106, 110, 112)).

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4. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni et al. (US 5,652,412) in view of Marianetti et al. (US 5,889,888) an in view of De Schrijver (WO 00/00928 cited by Applicant).

Regarding claim 14, Lazzouni et al. and Marianetti et al. do not disclose that the device as claim 1, wherein only a detachable part of the device is used as a pen for writing the command for carrying out the operation, the detachable part being adapted for communication with the rest of the device. De Schrijver discloses in figure 5, a device is a mobile telephone, wherein only a detachable part of the device is used as a pen for writing the command for carrying out the operation, the detachable part being adapted for communication with the rest of the device.

Regarding claim 15, Lazzouni et al. and Marianetti et al. do not disclose the device as claim 1, wherein the device has a first and second part which are separable and which have transceivers for mutual wireless communication, and wherein the device is controllable by the user using the first part as said pen, by means of which the command for initiating the operation is written. De Schrijver et al. discloses in figure 5, a device has a first (pen 2) and second part (telephone contains an antenna) which are separable and which have transceivers for mutual wireless communication, and wherein the device is controllable by the user using the first part as said pen, by means of which the command for initiating the operation is written (see p.11, lines 1-5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the using of the device having only a detachable part of the device is

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used as a pen for writing the command for carrying out the operation, the detachable part being adapted for communication with the rest of the device as taught by De schrijver into the system of Lazzouni et al. and Marianetti et al. because this would provide the wireless communication device and to generate ASCII text to be displayed to the user on the screen or transmitted to a remote site (see p. 11, lines 14-19).

### ***Response To Arguments***

5. Applicant's arguments filed on 11/23/05 have been fully considered but they are not persuasive.

Application states "The Examiner admits that Lazzouni et al. does not disclose the registering strokes when a device and interpretation means for determining if the strokes comprise a command. The Examiner relies on Marianetti, II et al. to cure the deficiencies of the teachings of Lazzouni et al. citing to the Abstract and column 4, lines 10-14. The Examiner concludes that it would have been obvious to one skilled in the art to combine the teachings of Marianetti, II et al. with the teachings of Lazzouni et al. because "this would recognize strokes that present characters from a different character set." Applicant respectfully disagrees with the Examiner's characterization of these references and further disagrees that there is sufficient motivation to combine the teachings of the references". Examiner respectfully disagrees because Lazzouni et al. discloses in fig. 3, a registration device (pen 10) is adapted to record the command electronically by detecting a position code arranged on a writing surface and command is written (see abstract, see col. 5, lines 7-12). However, Lazzouni et al. does not disclose the registering strokes when a device and interpretation means for determining if the strokes

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comprise a command. Marianetti, II et al. to cure the deficiencies of the teachings of Lazzouni et al. citing to the Abstract and column 4, lines 10-14, because Marianetti, II et al. disclose the registering strokes (see recognize strokes, see col. 2, lines 25-26) when a device and interpretation means (interpreted as alphabetic) for determining if the strokes comprise a command, and thus the interpreted as the numerals. Furthermore, the two references of Lazzouni et al. and Marianetti, II et al. are the same apparatus for writing surface and recording unit contains an electronic, therefore the combination of the two references are sense.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation for the rejection is found in Lazzouni et al. and Marianetti, II et al. are satisfied for its intended purpose because the two system having the same writing surface as discussed. For these reasons, the rejections are maintained.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimnhung Nguyen whose telephone number is (571) 272-7698. The examiner can normally be reached on MON-FRI, FROM 8:30 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kimnhung Nguyen  
February 8, 2006



**PATRICK N. EDOUARD**  
**SUPERVISORY PATENT EXAMINER**